

REMARKS

On April 11, 1996, Examiner Casler telephoned Applicants' undersigned counsel to inform him that the subject application would be deemed to be in condition for allowance if amended to further improve the clarity of Claims 164, 166, 167 and 168. In addition, it was pointed out that amendment of Claim 89 that was presented in the response under 37 C.F.R. 1.116 did not correctly set forth the language to be deleted and added. It was also noted that Claim 168, which had been drafted to incorporate limitations previously set forth in base Claim 89 and dependent Claims 110 and 111, apparently lacked a limitation relating to suppression of blood vessels. Moreover, the Examiner believed that applicants had neglected to cancel claims subject to objection for dependency upon rejected base claims, when they submitted new Claims 164-168 as claims that were rewritten in independent form to incorporate the subject matter of the objected claims, the respective base claims and all intervening claims.

During the telephone conference, agreement was reached as to minor amendment of Claims 164 and 167 to place those claims in strict compliance with the second paragraph of 35 U.S.C. 112. It was further agreed that those amendments would be implemented by Examiner's Amendment. To provide a clear record and allow applicants' counsel time to review the Examiner's comments as to the need to add an express limitation to Claim 168 that relates to suppression of blood vessel images, it was decided that applicants should submit a supplementary response after final for the review by the Examiner.

Applicants have reviewed the matter and propose amendment that is believed to address each area of concern. Proposed herein is amendment of Claim 89 in a manner that properly denotes language that has been added to the claim and language deleted from the claim. That is, Claim 89, as amended above, reflects differences between Claim 89 as it existed prior to final rejection and as it was presented in applicants' Response After Final. As was discussed in that response, the amendment that is being made is a result of a telephonic interview that took place on March 7, 1996 and is

1 reported in an Examiner Interview Summary Record (mailed March 12, 1996; Paper No. 18). There
2 are two changes, each of which was agreed upon during the referenced telephone conference. The
3 first change is amendment of Part (a) of Claim 89 to specify that the recited nerves include epineurium
4 and perineurium. The second change is amendment of Part (e) of Claim 89 to specify a conspicuity of
5 the imaged nerve that is at least 1.1 times that of any adjacent non-neural tissue. As is noted in the
6 Examiner Interview Summary Record, the Examiner's view was that the noted change to Part (e) of
7 Claim 89 is sufficient to define the subject matter of the claim over the prior art.

8 Since applicants have amended Claim 89 to properly reflect the referenced changes, Claim 89
9 is in condition for allowance.

10 The above set forth proposed amendment of Claim 166 cures a potential deficiency noted by
11 the Examiner during the April 11, 1996 telephonic conference. Specifically, the Examiner noted that
12 step (c) of Claim 168 called for "producing a separate output for each diffusion-weighted
13 gradient . . .," but that the only antecedent basis was recitation of "a predetermined arrangement of
14 gradients" (in step (a)). Applicants have reviewed the situation and propose amendment so that
15 step (a) recites a "predetermined arrangement of diffusion-weighted gradients" and parallel recitation
16 with respect to the "predetermined arrangement of gradients" previously recited at the end of step (c).
17 Accordingly, Claim 166 is believed to now be in condition for allowance.

18 The proposed amendment of Claim 168 adds the limitation relating to suppression of blood
19 vessels in step (e) of the claim process that was noted by the Examiner. In particular, step (e) of
20 Claim 168 now defines processing the recited signals "to generate a data set in which conspicuity of
21 the blood vessels is suppressed. . . ." Addition of that limitation brings Claim 168 into full alignment
22 with the combination of independent Claim 89 (prior to its amendment) and dependent Claims 110
23 and 111.

24 In addition to the above-noted amendment, Claim 168 has been amended for improved clarity
25 pursuant to suggestions made by the Examiner. In particular, step (a) of Claim 168 has been

1 amended to eliminate recitation that the non-neural tissue "may include" blood vessels in favor of
2 recitation of that the non-neural tissue includes blood vessels. Step (d) of Claim 168 has been
3 amended to adopt the Examiner's suggestion that the signal previously recited as an "output in which
4 the conspicuity of blood vessels is enhanced" be noted as a second output. A corresponding change
5 has been made to step (e) of Claim 168.

6 Since Claim 168 has been amended both for strict compliance with 35 U.S.C. § 112, second
7 paragraph, and, in addition, to more fully recite limitations set forth by the combination of Claim 89
8 (in its unamended form) and dependent Claims 110 and 111, Claim 168 is believed in condition for
9 allowance.

10 In reviewing the application, it was noted that claims previously objected to, but deemed
11 allowable if rewritten in independent form to incorporate all limitations in a chain of dependency,
12 were intentionally left in the application. In particular, independent Claim 89 is the base claim for
13 each claim that previously was deemed allowable if rewritten in dependent form to include the
14 limitations of the base claim and any intervening claims. Since independent Claim 89 has been
15 brought into condition for allowance, each of the claims previously meeting with objection are claims
16 that are dependent upon amended Claim 89. That is, it can be said that the claims previously subject
17 to objection now have a "new" base claim (amended Claim 89). Since amended Claim 89 is
18 allowable, the claims under discussion should not be subject to either objection or rejection.

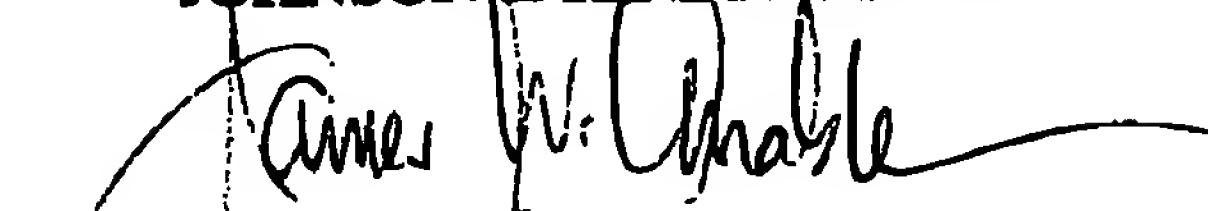
19 When applicants' counsel determined that the Examiner had not realized the reason why the
20 claims subject to objection had not been cancelled, an additional telephonic conference was initiated
21 (on April 12, 1996). During that conference, the Examiner concurred with applicants' view.

22 For the above-stated reasons, it is believed that all claims of this application are now in
23 condition for allowance (Claims 89-100, 102-104, 106-115, 117-138 and 150-168). Accordingly,
24 entry of this supplemental Response After Final, allowance and early passage to issuance are
25 respectfully requested.

1 For the Examiner's consideration, applicants note the suggested Claim sequence that was
2 submitted with the Response After Final.

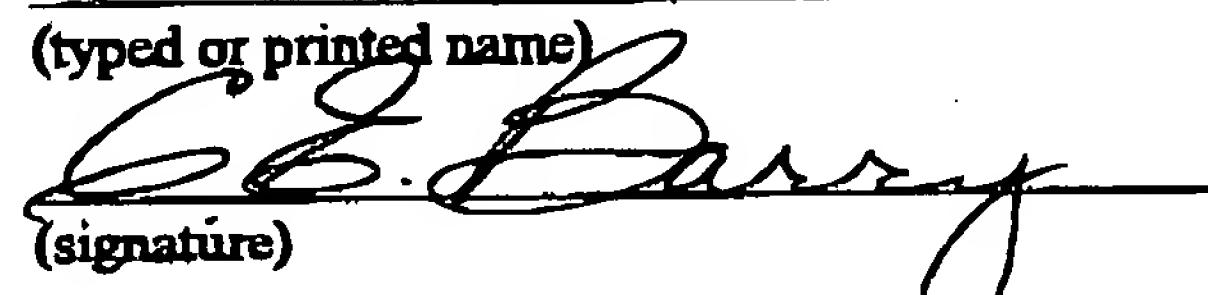
3 Respectfully submitted,

4 **CHRISTENSEN O'CONNOR**
5 **JOHNSON & KINDNESS PLLC**

6 
7 James W. Anable
8 Registration No. 26,827
9 Direct Dial (206) 224-0704

10 **CERTIFICATION OF FACSIMILE TRANSMISSION**

11 I hereby certify that this correspondence is facsimile transmitted to Examiner B. Casler at facsimile
12 No. 703-305-3590 at the U.S. Patent and Trademark Office via facsimile, on the date shown below.

13 Date: April 12, 1996
14 
15 JWA:teb
16
17
18
19
20
21
22
23
24
25

13 Christine E. Barry
14 (typed or printed name)
15 (signature)